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| APPLICATION NO.        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------|-------------|----------------------|---------------------|------------------|
| 10/798,611             | 03/10/2004  | Robert J. Simmons    | J-BSIM.1014         | 6188             |
| 56703                  | 7590        | 08/15/2007           | EXAMINER            |                  |
| ROBERT D. VARITZ, P.C. |             |                      | LAUX, JESSICA L     |                  |
| 4915 SE 33RD PLACE     |             |                      | ART UNIT            |                  |
| PORTLAND, OR 97202     |             |                      | PAPER NUMBER        |                  |
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|                        |             |                      | MAIL DATE           |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/798,611 | <b>Applicant(s)</b><br>SIMMONS, ROBERT J. |  |
|                              | <b>Examiner</b><br>Jessica Laux      | <b>Art Unit</b><br>3635                   |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 6-8 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1-5 (invention I) are drawn to a structural column apparatus, while claims 6-8 (invention II) are drawn to a method of fabricating a building including a foundation.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as for example inserting the column section in a telescopically related manner at the construction site or transporting the extended column structure to the jobsite.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search, including a separate search query (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 6-8 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Response to Arguments***

Applicant's arguments filed 05/29/2007 have been fully considered but they are not persuasive.

Applicant states in the remarks that Carter does not disclose a tubular column section receivable along a majority of the length, but rather discloses a that only a minor portion is receivable where the retainers are attached prior to assembly thus preventing the telescoping capability.

Examiner disagrees with these remarks noting Col. 5, lines 21 and 34-52, where Carter discloses that the retainers may be attached in the field and further disclosing that the overlap portion of the sections be sufficient to prevent later forces and prevent bending and that such an overlap distance may vary depending on the particular application and may have smaller or larger overlap distances.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because claim 1 recites "...is extendable therefrom...", while claim 2 recites "...said section are anchored to one another against relative motion between the sections...", which is contradictory. Claim 5 recites "...telescopically extended" and "...ends anchored" which is also contradictory.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by**

**Carter (6151851).**

Regarding claim 1: Carter discloses a structural column structure (10) comprising:

a first elongate, hollow and tubular column section (22) having a first defined-size cross section, and

a second elongate, hollow and tubular column section (52) having a second defined-size cross section which generally matches in character, but is smaller than, said first defined-size cross section, with said second section having a length portion (figures 3 & 4; 42, 60, 71) which is telescopically and nestingly fittingly received within a length portion of said first section (Col. 5, line 67- Col. 6, line 5), thus to produce a moment connection between the two sections, and wherein said second elongate, hollow and tubular column section is receivable along a majority of its length in said first elongate, hollow and tubular column and is extendable therefrom to an extended position (where the second column is capable of being received in the first column when the retainers are installed in the field).

Regarding claim 2: The column structure of claim 1, wherein said length portions are the same, and are lesser in size relative to the overall lengths of the respective, associated column sections (Col. 5, lines 47-48), and said sections are anchored to one another against relative motion between the sections (figures 3 & 4; 36, 58, 66),

whereby the overall length of the column structure is a step-tapered from one end to the other (figure 1 depicts a tapered column).

Regarding claims 3-4: The column structure of claim 1, wherein each of said cross sections is generally square in configuration (where figures 3-6 depict generally square cross sections).

Regarding claim 5: A multi-story building frame structure comprising:  
plural, elongate, upright and laterally spaced columns (10, figure 1), each including plural elongate, hollow and tubular, telescopically interrelated and nested sections (22, 52, 82; figures 3-6) which have differently sized overall cross sections (where figure 1 depicts a tapered column), and with respect to which vertically next-adjacent sections longitudinally overlap one another with one section disposed inside the other to establish moment connections between each two such next-adjacent sections (figures 3-6), wherein said nested section are receivable along a majority of their length in a next larger nested section to facilitate transport (where the second column is capable of being received in the first column when the retainers are installed in the field), and wherein the columns are capable of being telescopically extended and fastened for final assembly, and

anchoring zones (figures 1 and 2, which depict zones for anchoring at the connection of vertically adjacent sections) defined on the outsides of the larger cross-section column sections in each region of such longitudinal overlap between vertically next –adjacent column sections, and

plural, elongate, generally horizontally disposed beams (the floors 14, 16, 18) extending between laterally next-adjacent columns, and having ends anchored to a spaced pair of said anchoring zones.

(It should be noted that the limitation "...and wherein said nested sections are telescopically extended and fastened to adjacent nested sections for final assembly thereof" is considered a product-by-process limitation. The patentability of the product does not depend on its method of production. Determination of patentability is based on the product itself. See MPEP 2113. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 6:30am to 2:30pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JEANETTE CHAPMAN/  
PRIMARY EXAMINER  
ART UNIT 3635

JL  
08/7/2007